REMARKS

Claims 1–21 are pending in the application. These claims were rejected as follows:

Claims / Section	35 U.S.C. Sec.	References / Notes
Drawings	Objection	• Reference numbers 29 and 36 not described
Specification	Objection	• Use of trademark symbols; • Lack of antecedent basis for claims 9, 10; and • Typographical errors.
1, 6, 12, & 21	Objection	• Claim phraseology.
3, 4, 7, 9, 10, & 21	§112, Second Paragraph Indefiniteness	• Specific claim language used; • Trademark-related issues; and • Phraseology and antecedent basis.
1–7 & 9–10	§103(a) Obviousness	• Kawan (U.S. Patent No. 5,796,832); • Piikivi (U.S. Patent Pub. No. 2002/0198849); and • Crevelt, et al. (U.S. Patent No. 5,902,983).
8	§103(a) Obviousness	• Kawan (U.S. Patent No. 5,796,832); • Piikivi (U.S. Patent Pub. No. 2002/0198849); • Crevelt, et al. (U.S. Patent No. 5,902,983); and • Sharp, et al. (U.S. Patent Pub. No. 2002/0002510).
21	§103(a) Obviousness	• Kawan (U.S. Patent No. 5,796,832); and • Piikivi (U.S. Patent Pub. No. 2002/0198849).

Applicants have amended claims 1–4, 6, 7, 9. 10, and 21 and have also provided discussion for distinguishing the present invention, with claims as amended, from the art cited against it.

Applicants' use of reference characters below is for illustrative purposes only and is not intended to be limiting in nature unless explicitly indicated.

OBJECTIONS TOTHE DRAWINGS

1. Applicants have amended the Specification to describe the reference numbers shown in the drawings.

In the OA, on p. 2, under numbered paragraph 2, the Examiner objected to the drawings as failing to show reference numbers 29 and 36. These reference numbers have been added to the descriptive portion of the Specification. Since this added descriptive portion in the Specification is limited to what is clearly shown in the drawings, no new matter has been added to the application.

OBJECTIONS TO THE SPECIFICATION

2. Applicants have amended the Specification to make proper use of the trademark symbol, where appropriate.

In the OA, on p. 2, under numbered paragraph 3, the Examiner noted that the proprietary nature of trademarks should be respected.

Therefore, Applicants have added the trademark designation, where appropriate (and where suggested by the Examiner), to the Specification.

3. Applicants have amended claims 9 and 10 to expressly identify those claim elements that are executed contemporaneously or proximate to one another.

In the OA, on p. 3, under numbered paragraph 4, the Examiner objected to claims 9 and 10 as including limitations not described in the Specification. Applicants have amended claims 9 and 10 to affirmatively claim the method steps

being performed contemporaneously, and respectively a geographically proximate manner. Furthermore, the Specification does disclose the claimed limitations in view of the combined disclosure of paragraph 26 along with the disclosure of Figure 3 (see reference number 142) and appertaining paragraphs 39 and 40.

4. Applicants have amended paragraph 41 to correct the reference numbers 152 and 154.

In the OA, on pp. 3–4, under numbered paragraph 5, the Examiner noted, in essence, that the reference numbers 152 and 154 appeared to be reversed in paragraph 41. Applicants have amended paragraph 41 to refer to the correct reference numbers, as indicated by the Examiner.

OBJECTIONS TO CLAIMS 1, 2, 6, AND 21

5. Applicants have amended claims 1, 2, 6, and 21 to address the problematic terminology noted by the Examiner.

In the OA, on p. 4, under numbered paragraph 6, the Examiner noted problematic terminology in claims 1, 2, 6, and 21. Applicants have amended claims 1, 2, and 6 in accordance with the Examiner's suggestions for clarifying the claims. With regard to claim 21, this claim has been amended to refer to a common short-range network with separate short-range communication mechanisms on the retail charging terminal and the mobile appliance that both access the common short-range network.

Based on the amendments to the Specification and the claims, Applicants assert that all of the Examiner's bases for objection have been fully addressed and respectfully request that the objections be withdrawn from the application.

35 U.S.C. §112, SECOND PARAGRAPH, CLAIMS 3, 4, 7, 9, 10, AND 21 INDEFINITENESS

6. Claims 3, 4, 7, 9, 10, and 21 have been amended to address the indefiniteness issues raised by the Examiner.

In the OA, on pp. 4–6, the Examiner rejected claims 3, 4, 7, 9, 10, and 21 as being indefinite.

With regard to claims 3 and 4, the Examiner proposed claim language for clarifying aspects related to the transfer of money—the language proposed by the Examiner has been adopted in the Applicants' amendments to these claims.

With regard to claim 7, the Examiner noted that were a trademark or trade name is used in a claim to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. §112, second paragraph. The Examiner further noted that a trademark or trade name is used to identify a source of goods and not the goods themselves.

MPEP §2175.05(u) indicates that the presence of a trademark or trade name in a claim is not, *per se,* improper under 35 U.S.C 112, second paragraph, but that the claim should be carefully analyzed to determine how the mark or name is used in the claim.

Claim 7 has been amended to indicate that the trade names themselves are not being used, which would constitute an impermissible description of a source of goods, but rather that the protocol specifications corresponding to the

related trade names are being claimed. A reference to the protocol specifications related to the trade names, therefore, does not run afoul of the prohibition on using trademarks or trade names to identify a source of goods themselves.

Claims 9 and 10 have been amended to specifically cite the method steps being referred to, as suggested by the Examiner, and has eliminated the reference to "electronic cash".

Claim 21 has been amended to clarify that both the retail charging unit and the mobile appliance each have short-range communications network mechanisms (hardware and/or software) that share a common short-range communications network.

35 U.S.C. §103(a), CLAIMS 1–7 AND 9–10 OBVIOUSNESS OVER KAWAN IN VIEW OF PIIKIVI AND CREVELT

7. Claim 1 has been amended to require that the retail charging terminal is located in geographic proximity to the retailer and further that the electronically transferred money is utilized to make the purchase. These amended claim features are not disclosed by the combination of Kawan, Piikivi, and Crevelt.

In the OA, on pp. 6–8, the Examiner rejected claim 1 as being obvious over the combination of Kawan, Piikivi, and Crevelt, citing the features disclosed by each of these references, and noting that it would be obvious for one of ordinary skill in the art to combine the teachings of these references to arrive at the present invention.

Claim 1 has been amended to indicate that the retail charging terminal is located in geographic proximity to the retailer. This feature cannot be found in the combined teachings of Kawan, Piikivi, and Crevelt.

Kawan teaches a wireless terminal 100 that can be used to wirelessly communicate with a financial institution 10. The terminal comprises a smart card interface and the terminal 100 can be used to debit a particular dollar amount from the user's account and add this dollar amount to the user's smart card.

Applicants agree with the Examiner's characterization on p. 7 that Kawan fails to specifically teach purchasing an opportunity in a game of chance, giving the amount of money to a retailer who is an authorized agent for the game of chance, or the user of a mobile appliance.

The Examiner provides the Piikivi reference for its teaching of known payment procedures called by mobile banks used by companies with accounts for each customer, where the account's funds are transferred by the user from his other source (a separate bank account), where use of the mobile bank system is limited to service or goods providers who have made an agreement with the mobile bank. The Examiner notes that Piikivi also teaches that money can be stored in a SIM/smart card of the mobile device.

Finally, the Examiner cites Crevelt as teaching that it is well known in the art for cashless credit systems to be implemented for wagering in casino establishments.

Applicants do not necessarily disagree with the Examiner's characterization of the teaching of these references, but do assert that it would

not be obvious to combine these references to arrive at the present invention, particularly with claims as amended. Applicants have amended independent claims 1 and 21 to require that the retail charging terminal is located in geographic proximity to the retailer, and that money is given by the user to the retailer. This is substantially different than what is disclosed by the teaching of Kawan, Piikivi, and Crevelt.

The present invention, with claims as amended, is specifically applied to the field of making retail purchases for games of chance or scenarios where retail purchases are made over a long-range wireless communications network. With the traditional purchasing systems, such as that disclosed in Kawan, the user puts money in a remotely located account and then the retail charging unit connects with the remote account to input money onto the user's smart card. However, regulatory constraints that apply uniquely to the gaming industry do not permit remotely deposited money to be applied to a gaming device in such a manner as disclosed by Kawan. The money must be paid at the retailer's (who is an authorized agent for the game of chance) site, at which point the money can then be transferred, via the recharging terminal, to the mobile appliance of the user. Thus, the presently amended independent claim 1 particularly address a situation that is structured for the regulated situation that involves purchases related to games of chance, using money that has been transferred to the mobile appliance.

Although claim 21 is not restricted to retailers of games of chance and playing games of chance, it is limited to a situation in which the money is paid to

a retailer and a retail charging terminal located at the retailer is used to transfer money to a mobile appliance that is then used to make the retail purchase.

Neither Kawan nor Piikivi teach or suggest money, at a retailer's establishment, being given by the user to the retailer where it is transferred to a retail charging terminal located geographically proximate the retailer, and then from the charging terminal to the user's mobile appliance. In both of these references, the money ultimately received by the user is located remotely from the retailer, a condition expressly prohibited by regulation and therefore unworkable when applied in the context of games of chance, and a condition that may be precluded in certain other retail purchase contexts.

It is true that Crevelt teaches that it is well known in the art for cashless credit systems to be implemented for wagering in casino establishments, but again, Crevelt deals with access to cash located at a remote financial institution (see 2:9). In none of these systems is the problem dealt with of having a requirement to transfer cash from a user on-site to a retailer having on-site a retail charging terminal and a charging of the user's mobile appliance with the cash that was handed over to the retailer, nor would it be obvious to do so in a context that did not have such regulatory or business related requirements. In these contexts, the retailers would rely upon the user's remote institution and accounting protocols separate from the retailer to handle the movement of money into the user's mobile appliance.

Furthermore, although these references teach a transfer of money to a smart card or SIM of the user, they do not take it an extra step and show that the

smart card or SIM goes into the mobile appliance that can then be utilized to play games of chance that had been purchased. The teaching of downloading electronic money into a SIM or smart card that is then placed in a mobile appliance, as taught by Piikivi, does not teach or suggest access by that device to the game of chance or other vendor service. Piikivi and the other references merely suggest applications that are used for accessing the user account information itself, and do not deal with a use of the downloaded electronic money to subsequently purchase goods or services.

35 U.S.C. §103(a), CLAIM 8 OBVIOUSNESS OVER KAWAN IN VIEW OF PIIKIVI, CREVELT, AND SHARP

8. The addition of Sharp to the combination of references, as applied to claim 8, fails to provide the missing teaching of using the electronically transferred money to purchase the opportunity in the game of chance.

In the OA, on pp. 13–14, the Examiner rejected claim 8 as being obvious over the combination of Kawan, Piikivi, Crevelt, and Sharp, citing the features disclosed by each of these references, and noting that it would be obvious for one of ordinary skill in the art to download the games from a game server over a long-range communications network.

Claim 1, from which claim 8 depends, requires that the mobile appliance is utilized to purchase the opportunity in the game of chance with the electronically transferred money. The addition of Sharp, which the Examiner adds as teaching the downloading of games to a mobile appliance over a long-range network, fails to provide what is missing from the teaching of Kawan, Piikivi, and Crevelt for this element.

Sharp, at paragraph 0039, deals with handling remote account data and providing that a separate accounting system is able to properly ensure that the proper charges and reimbursements are handled. Sharp states:

> [0039] Such confirmation of receipt and acceptance is passed to an accounting system 50 which registers this acceptance, and then performs computations to determine the charge to be made to the user, as indicated at block 190. The charge to the user for the adaptation data may be a fixed flat rate fee or on the basis of airtime, or by some other measure. The operator in turn reimburses the mobile phone manufacturer. For example, the operator server accounting system may send a signal to the manufacturer's server that a download of adaptation data has been successfully executed. This signal is then registered in some form of counting means provided in the server. Alternatively, the server could be equipped with counting means that monitors the volume of downloads that the server is performing. The counting means could be linked at the server to an accounting system that on the basis of the level of successful downloads from the server computes the payment to he made to the content provider. In this way, the content provider generates revenue for the original games content by receiving the payments for the downloads of adaptation data. Thus a substantial amount of the income of the games content taken as a whole is generated through remuneration from the adaptation data.

This disclosure of Sharp does not address the use of funds transferred to the mobile appliance for the purchase of the opportunity in the game of chance, and therefore does not, in combination with Kawan, Piikivi, and Crevelt, serve to obviate claim 8.

For these reasons, the Applicant asserts that the amended claim language clearly distinguishes over the prior art, and respectfully request that the Examiner withdraw the §103(a) rejection from the present application.

CONCLUSION

Inasmuch as each of the objections have been overcome by the amendments, and all of the Examiner's suggestions and requirements have been satisfied, it is respectfully requested that the present application be reconsidered, the rejections be withdrawn and that a timely Notice of Allowance be issued in this case.

Any shortages of fees due may be charged to, and any overpayments may be credited to, deposit account no. 50-1519.

Respectfully submitted,

/Mark Bergner/____ (Reg. No. 45,877)

Mark Bergner
SCHIFF HARDIN, LLP
PATENT DEPARTMENT
6600 Sears Tower
Chicago, Illinois 60606-6473
(312) 258-5779
Attorney for Applicants
Customer Number 26574